

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

40-002001US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on Sept 10, 2008

Signature [Signature]

Typed or printed name Evelyn Gomez

Application Number

10/826,153

Filed

April 16, 2004

First Named Inventor

Erik Scher

Art Unit

1631

Examiner

Russell Scott Negin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 41,595

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

[Signature]

Signature

Gary Baker

Typed or printed name

(510) 337-7871

Telephone number

September 10, 2008

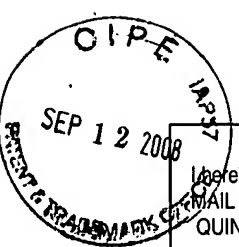
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service first class mail in an envelope addressed to:
MAIL STOP AE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on Sept. 10, 2008
QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.

By: _____

Evelyn Gomez

Appl. No. 10/826,153
Applicant: Erik Scher et al.
Filed: April 16, 2004
TC/A.U. 1631
Examiner: Russell Scott Negin

Confirmation No. 8584
Docket No.: 40-002001US
Customer No.: 22798
Client Ref No.: 01-002001

REASONS FOR REVIEW REQUEST
(Accompanying Form PTO/SB/33, Pre-Appeal Brief Request for Review)

In response to the final Office Action dated April 29, 2008, and the Advisory Action dated July 24, 2008, Applicants herein submit a Request for a Pre-Appeal Brief Conference and accompanying Notice of Appeal. Applicants submit that the rejections of record are not proper and without basis, and respectfully request that rejections for alleged obviousness be withdrawn. Applicants stand by but do not attempt to present all valid arguments for allowance of all claims, but focus on key errors in the rejection of the independent claim.

A. The Rejection of Independent Claim 26 Under 35 U.S.C. § 103 is Improper

The Office is incorrect in alleging that any cited reference describes a mixture of two or more populations of nanocrystals. Independent claim 26 is directed to a composition comprising "a mixture of two or more subsets of nanocrystals, the subsets characterized by different excitation wavelengths; wherein the emissions of the population comprise different wavelengths or different wavelength intensities when alternately excited with the different excitation wavelengths". The Examiner continues rejections based on the allegation that the limitation of mixed nanocrystal populations can be found in Bruchez (U.S. 6,274,323), but the cited teachings simply do not teach mixtures of different nanocrystals to one of skill in the art. The rejection also requires that nanocrystal populations must inherently have different emissions on stimulation with different excitation wavelengths - but this is not necessarily so. The claims are not obvious, at least because not all limitations of the claims are taught to one of skill in the art.

First the Examiner finds a mixture of different nanocrystals at Bruchez column 8, line 44 (the lead-in to the Definitions section of the specification):

"As used in this specification and the appended claims, the singular forms 'a,' 'an' and 'the' include plural references unless the content clearly dictates otherwise. Thus, for

example, reference to 'a semiconductor nanocrystal' includes a mixture of two or more such semiconductor nanocrystals, an 'analyte' includes more than one such analyte, and the like." Emphasis added.

The title sentence of the paragraph sets the context as "plural references" to singular forms, which even laymen understand means more than one of the singular item, not mixtures of different items. Applicants note, this paragraph is standard patent application boilerplate commonly inserted into applications to avoid the linguistic trap wherein discussion of "a" composition component is interpreted to exclude the concept of two or more of the same component from the scope of the claims or from the recognized disclosure. For example, an inventor would not want his assay method claims limited to detection of assay samples containing only one molecule of the analyte of interest. In the context of the cited paragraph concerning singular and plural expressions, one of skill in the art would know Bruchez was establishing that the phrase "a semiconductor nanocrystal" teaches and supports claims to two or more of the nanocrystal. There is no allusion in the citation to mixtures of different nanocrystals, only an inclusion of more than one such nanocrystal where the reference singularly refers to a nanocrystal. The cited phrase does not expressly or inherently teach mixtures of different nanocrystals.

In the Advisory Action, the Examiner argues that the column 8, line 44, citation teaches the required mixture "because all passages of the prior art are given the same weight when analyzing the instant invention, whether the teaching in the prior art is a central aspect of the art or an alleged formality." The Examiner does not cite support in the law for this rule; it does not make sense; and, it can not provide a basis for rejecting the present claims. To the contrary, Applicants note that all passages of prior art are not to be given the same weight, but are to be interpreted (and given appropriate weight) according to what would be understood by one of skill in the art. See, *Phillips v. AWH Corp*, 376 F.3d 1382; 2004; and, *Ex parte Levengood*, 28 USPQ2d 1300; 1993. Further, even assuming maximum "weight" were given the citation, this still could not change the meaning of what is said. The statement can not stand as a basis for the rejections.

Second, the Examiner allegedly finds different populations of nanocrystals mixed together at column 17, line 10 of Bruchez:

"[E]xemplary materials for use as semiconductor nanocrystals in the biological and chemical assays include ... ZnS, ZnSe, ZnTe, CdS ... [etc.] Ge, and Si and ternary and quaternary mixtures thereof."

There is not any reference to "mixtures of species of nanocrystals" here. Unambiguously, the subject of the cited sentence is "exemplary materials" for use in semiconductors, and possible mixtures of the materials. The term "mixtures thereof" refers to foregoing materials listing, not to species of nanocrystals. For example, the Examiner would have the grammar of the sentence nonsensically twisted to read - "Exemplary materials ... include ZnS, ZnSe, [etc.] Ge and Si ... and quaternary mixtures [of nanocrystals]." One of skill (and laymen also) would interpret the cited sentence to mean - "Exemplary materials ... include ZnS, ZnSe, [etc.] Ge and Si ... and quaternary mixtures [of these materials]." The cited misinterpretation of Bruchez at column 17 does not form the basis for rejection of the claims.

Applicant's representative is somewhat perplexed by the statement on line 15 of the Advisory Action Continuation Sheet that "Applicant supports the fact that the method of Bruchez et al. can be used to generate mixtures of nanocrystals by citing lines 10-15 of column 17 ... wherein ternary and quaternary mixtures were disclosed." Applicants emphatically do not support the statement, and have not. Applicants agree that more than one separate different nanocrystal existed in the universe, and even in Bruchez, before the present invention, but mixtures of nanocrystals are not taught in Bruchez; particularly not at column 17.

Applicants have previously noted that although Bruchez does not teach mixtures of different nanocrystals, assuming *arguendo* that the separate nanocrystals could be mixed, such admixture is not inherently taught in Bruchez. See, e.g., *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991), and *In re Oelrich*, 666 F.2d 578, 581 - 82, 212 USPQ 323, 326 (CCPA 1981). Applicants further note that even if an aspect were inherent, but unstated, in a reference, it would not provide a teaching that could render the aspect obvious to one of skill in the art. That is, hidden facts do not teach.

Third, Applicants note that the Advisory Action no longer argues rejections based on the preparation of "separate populations" of semiconductor nanocrystals in column 19, line 23, of Bruchez.

Fourth, claim 26 is additionally not obvious for failure of the Actions to cite a reference teaching of the claim limitation "wherein the emissions of the population comprise different wavelengths or different wavelength intensities when alternately excited with the different excitation wavelengths". In the Action of December 27, 2007, the Examiner cursorily stated that this aspect is "inherent". However, Applicants await a fact-based response to the observation (Response of January 25, 2008) that even assuming a mixed population of different nanocrystals, different emissions are not taught or inherent when the nanocrystals are alternately excited by different characterized excitation wavelengths. For example, different nanocrystals can have the same characteristic excitation wavelengths; and, mixtures of different nanocrystals can have similar combined emissions with alternate excitation with different excitation wavelengths. Therefore, assuming a teaching of mixed different nanocrystals, the claim would still not be taught or inherent, much less obvious.

With regard to all dependent claims, they are not obvious at least for dependence on non-obvious independent claim 26.

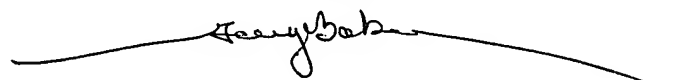
B. Summary

In order to facilitate progress in this case, Applicants respectfully request a reasoned statement specifying the basis for any decision provided.

Applicants submit that the claims are meet the requirements of 35 U.S.C. §§ 102, 103 and 112, being novel, non-obvious and extensively described in the specification. In light of the summary provided herein and the extensive prosecution history, Applicants respectfully request that the rejections be withdrawn and that the claims be considered Allowable.

QUINE INTELLECTUAL PROPERTY LAW GROUP
P.O. BOX 458, Alameda, CA 94501
Tel: 510 337-7871
Fax: 510 337-7877
PTO Customer No.: **22798**
Deposit Account No.: **50-0893**

Respectfully submitted,



Gary Baker
Reg. No: 41,595

Attachments: 1) Notice of Appeal; 2); Form PTO/SB/33 (Pre-Appeal Brief Request for Review); 3) petition to extend the period of response; 4) A transmittal sheet; 5) fee transmittal sheet; and, 6) receipt indication postcard.